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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/896,094	06/28/2001	Masataka Shinoda	09792909-5049	9407

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EXAMINER

MCPHERSON, JOHN A

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 03/11/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/896,094

Applicant(s)

SHINODA, MASATAKA

Examiner

John A. McPherson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-93 is/are pending in the application.
- 4a) Of the above claim(s) 44-93 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I, claims 1-43 in Paper No. 6 is acknowledged. Claims 44-93 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14, 25, 42 and 43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 recites the limitation "'said light transmission recording material" in line

2. There is insufficient antecedent basis for this limitation in the claim.

Claim 25 recites the limitation "said information" in line 3, however it is not clear if this is a reference to "information A" only, "Information B" only, or to both "information A" and "Information B" together.

Claims 42 and 43 each recites the limitation "said inherent identification information" (line 2 of claim 42, and in lines 2 and 3-4 of claim 43). There is insufficient antecedent basis for this limitation in the claim.

Claim Objections

3. Claims 34-41 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claims 34-41 each includes a limitation in which information is to be recorded by at least any of a change of multi-value refractive index or a change or multi-value extinction coefficient or by at least any one of a change of multi-value transmittance or a change of multi-value reflectance.

However, claims 34, 36, 38 and 40 depend from claims 1 or 2, with claims 1 and 2 both requiring information to be recorded by at least one of a change of refractive index or a change of extinction coefficient (i.e. not by changes in transmittance and/or reflectance). Therefore, the embodiments "or by any one of a change of multi-value transmittance or a change of multi-value reflectance" in claims 34, 36, 28 and 40 are outside the scope of claims 1 and 2, which require changes in refractive index and/or extinction coefficient.

Similarly, claims 35, 37, 39 and 41 depend from claims 3 or 4, with claims 3 and 4 both requiring information to be recorded by at least one of a change of transmittance or a change of reflectance (i.e. not by changes in refractive index and/or extinction coefficient). Therefore, the embodiments "or by any one of a change of multi-value refractive index or a change of multi-value extinction coefficient" in claims 35, 37, 39

and 41 are outside the scope of claims 3 and 4, which require changes in transmittance and/or reflectance.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-43 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,975,355 (US '355). US '355 discloses an optical disk comprising a polycarbonate substrate, a specified phase change recording layer, and a surface protective layer made of an ultraviolet curable resin. See the abstract. The limitation "is to be recorded" in line 3 of claims 1-2 and line 6 of claims 3-4 of the present invention is a statement of intended use for the claimed (unrecorded) recording medium, and therefore does not provide a distinction over a recording medium in the prior art having the same structure and made of the same materials (but not having information recorded in a light transmission material portion thereof, such as the substrate and/or protecting film).

5. Claims 1-2, 5-6, 9-10, 13, 16, 18, 20, 22, 34, 36, 38 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,761,111 (US '111). US '111 discloses an optical information storage medium wherein regularly-shaped structures of high-contrast refractive index are provided in a transparent storage medium by controllably focusing

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ultrashort laser pulses during recording, thereby recording digital or non-digital information, such as characters, security codes and images, capable of being read by the unaided eye, or by scattered or transmitted light (i.e. as a change in transmittance or reflectance, as required in claim 3-4). See the abstract. Furthermore, with respect to claims 3-4 and the claims which depend therefrom, the examiner notes that changes of transmittance or reflectance inherently result from a change in refractive index (e.g. see page 49, lines 11-15 of the present specification).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John A. McPherson whose telephone number is (571) 272-1386. The examiner can normally be reached on Monday through Friday, 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on (571) 272-1385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John A. McPherson
Primary Examiner
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JAM
3/8/04